

REMARKS

Overview

Claims 1, 2, 5, 6, 9-11, 15 and 16-20 are pending in the present application and all claims have been rejected.

Claim Rejections

Claims 1, 2, 5, 6, 9-11, 15 and 16-20 have been rejected under 35 U.S.C. § 103 as being obvious over Thompson. Claims 12-14 have been rejected under 35 U.S.C. § 103 as being obvious over the combination of Thompson and Busch. Applicant respectfully traverses these rejections as requests reconsideration of the claims.

1. The Claims Distinguish Over Thompson

All of the claims are directed towards a roulette style game wherein the wheel has 49 or 50 regions. The Examiner acknowledges that Thompson does not teach this limitation of 49 or 50 regions, but rather teaches 54 regions. The Examiner concludes that it is an obvious matter of design choice to change from 54 regions of Thompson to the 49 or 50 regions of Applicant's invention. However, the Examiner has provided no explanation to support this conclusion. Therefore, the rejection cannot stand.

As discussed in detail in Applicant's previous amendment dated September 4, 2007, the Supreme Court's KSR decision analyzed obviousness in several ways. If the combination of old elements has no change in function, the combination is obvious. Similarly, arranging old elements to perform the same function is obvious. Also, the predictable use of the prior art elements according to their established functions is obvious. 127 S. Ct. 1727, 2739-41 (2007).

In the present application, it is undisputed that the function of the 49 or 50 selectable regions is different than the 54 regions of Thompson. The 49/50 region wheel of Applicant's invention results in constant profit, as compared to the variable profit of the Thompson 54 region wheel. See Tables 4 and 6 of Applicant's Specification at pages 25-27 for the consistent profitability of 50 and 49 region wheels, respectively, compared to Table 1 at pages 23-24 of the Specification for 53/54 region wheels. Also, Applicant's 49/50 region wheel has a different function regarding the payout odds, which are whole, round numbers, as compared to the fractional number payouts resulting with 53/54 region wheels, such as Thompson. These simplified payouts make the operator's work easier for Applicant's invention, as compared to the Thompson invention. Applicant's invention also offers the player a better return than the standard 54 region roulette wheel, which is another functional difference. See Applicant's Specification at page 26, lines 9-11.

Thus, Applicant's 49/50 region wheel is functionally different than Thompson's 53/54 region wheel. This functional difference is strong evidence of non-obviousness. Such different functionality is more than a mere design choice, in that Applicant's wheel provides the benefits of consistent profitability for the house, increased returns to the players, and simplifies work for the operator.

KSR also set forth other tests of obviousness, such as a known pre-existing problem with an obvious solution, or design need or market pressure to solve a problem with a finite number of identified predictable solutions. Id. at 1741-42. Here, the Examiner has not identified any known problems, design needs, or market pressure which have led to Applicant's invention. Thus, these alternative obviousness tests of KSR have not been met.

In short, the Examiner has not provided any articulated reasoning with rational underpinning in support of the § 103 rejection, as required by KSR. Id. at 1741.

Furthermore, the claimed invention is different from Thompson, in that there is a payout with Applicant's invention after each spin of the wheel, whereas Thompson pays out only after multiple spins of the wheel to form poker hands. Thus, the requirements of claims 1, 10 and 15 regarding the single operation of the wheel are not satisfied by Thompson. Also, if 3-4 card regions are removed from the Thompson wheel, all poker hands normally associated with a full deck of cards are not available, because certain cards are missing. Thus, Applicant's invention cannot be used for playing poker, as in Thompson. Removing card regions from Thompson, as suggested by the Examiner, would destroy Thompson's poker game. This is yet another functional difference between Applicant's claimed invention and the cited reference. As the Federal Circuit stated long ago, it is not obvious to modify a prior art reference in a manner inconsistent with the reference. In re Gorden, 733 F.2d 900, 902 (Fed. Cir. 1984).

2. Commercial Success Demonstrates Non-Obviousness

On page 4 of the Office Action, the Examiner has declined to consider Applicant's commercial success submitted in the prior amendment, since Applicant's invention "does not appear to be novel." However, the claims are not rejection under § 102 as lacking novelty. Therefore, the Examiner's premise for disregarding Applicant's commercial success is fatally flawed. The MPEP expressly states that evidence of commercial success must be considered when presented in determining obviousness. See MPEP § 716.01(a). Thus, Applicant's commercial success cannot be ignored.

Also, gambling is a highly regulated industry around the world. Many countries have governing bodies for the gambling industry which must license a new game before it can be played in casinos (beyond a preliminary trial period).

It is also difficult to get a new gambling game, such as Applicant's invention, into a casino, unless the casino considers that the game is going to be successful. Casinos have limited floor space for testing or trialing new games, and will not trial new games that may cut into casino profits of established games. As a result, very few new table games are successfully implemented into casinos. Applicant is aware of only five other new table games successfully introduced into casinos around the world in the past 12 years. Merely exhibiting new games at expos and gaming shows does not necessarily proceed to casino trials of the games. However, successful trials of new games at casinos demonstrates the commercial interest in the game.

There are many steps that a new gambling game must go through before becoming licensed in a region. In particular, before a new game can be operated in a casino, the game concept, math, and probabilities, as well as the game apparatus, need to be approved by the governing territorial body for licensing in the casino's region. The game must be distributed by a company which is licensed in that territory, and to get a distributor, probity checks must be completed, and a game needs to meet certain parameters, such as a maximum house percentage, which is set by the licensing body for that territory. Next, the distributor must find a casino within the territory that will sponsor a trial of the new game, which involves putting the game on the floor to assess its worth with actual paying customers, while also removing a proven paying game from the floor. The game's trial results must meet the casino's objectives, which include a house advantage within an approved licensing range, an appeal to the customer's or clients, ease in training of staff operators of the game, a monetary return equal to or better than the table being

replaced, and other indirect benefits to the casino, such as adding variety to the floor, and alternatives for existing players which is easy to learn. Following the casino trials, the casino and the distributor submit the trial data to the licensing authority (such as the Nevada State Gaming Licensing Commission for Las Vegas casinos) to obtain game licensing for the region. Once the game is licensed for a region, no further trials in that region for other casinos are required.

Applicant's game has been successfully trialed in several countries. More specifically, at Ireland's largest casino, the game accounted for 28% of the casino monthly profit after only two weeks. On one trial day, the game had the highest revenue of any table in the casino. In Johannesburg, South Africa, the game ranked 5th out of 65 table games in casino profits.

Additional trials have also been conducted in Polokwane, South Africa, Nepal, and Sidney, Australia. As a result of the successful trials in South Africa, three of the four largest casino groups in the country are planning to launch the game. The game will also be launched in Russia later this year. Additional trials are also being finalized in other casinos in Australia, South Africa, New Orleans, and on a major Caribbean cruise ship line. Upon obtaining regulatory approval in further jurisdictions for the game and gaming apparatus, 20 additional casinos have expressed interest in trialing the game. Applicant has also been approached by major North American and European distributors to become distributors of the game following highly successful demonstrations at various gaming expositions and shows. Distributors have already been established for the USA, S. Africa, Eastern Europe, Macao, and Australia, with other territories having potential distributors being finalized in order to commercialize the game in those territories. Additional distributors have expressed interest in Asia and the United Kingdom.

Given the multi-step process required for new games to obtain regulatory approval and casino acceptance, Applicant's past, ongoing and future casino trials and distributorship agreements demonstrate the commercial success of this innovative game.

Conclusion

For all of the above reasons, the claims distinguish over the cited reference structurally and functionally, and the commercial success is strong evidence of non-obviousness. Accordingly, Applicant respectfully request that the rejections be withdrawn and that a Notice of Allowance be issued.

Please consider this a Request for a Three-Month Extension of Time from May 1, 2008 to August 1, 2008 and charge Deposit Account No. 26-0084 the amount of \$525.00 for this extension.

No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



KIRK M. HARTUNG, Reg. No. 31,021
McKEE, VOORHEES & SEASE, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
CUSTOMER NO: 22885

- bjh/pw -

Attorneys of Record